

### Remarks

In response to the Office Action dated January 04, 2008, Applicants respectfully request reconsideration based on the above claim amendment and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance. Claims 1 and 8 have been amended.

### 102 Rejections

In the Office Action, claims 8 and 9 are rejected under 35 U.S.C. §102(c) as being anticipated by McDowell. Amended independent claim 8 recites in pertinent part:

“[a] method of receiving data sent from a first computing device to a plurality of second computing devices over a wireless digital packet-switched network...comprising...receiving data from **an instant messaging application running on the first computing device** over a wireless digital packet-switched network...determining a plurality of intended recipients of the data at the messaging server“...and forwarding the data from the messaging server directly to the intended recipients...”.

To anticipate, a reference must describe each and every element of the claims. (MPEP 2131). Applicants respectfully assert that McDowell fails to describe an “instant messaging application running on the first computing device” and fails to describe “determining a plurality of intended recipients of the data at the messaging server”.

On page 2, the Office Action expressly equates the wireless subscriber device **210**, WAP Gateway **136** and **IM Server** of McDowell (See Fig. 2) to the first computing device, protocol server and instant messaging server, respectively, as recited in independent claim 8. The Office Action continues on to assert that wireless subscriber device **210** of McDowell contains and executes both an IM messaging application (a “WAP IM”) and a WAP browser and also asserts that the wireless subscriber device **210** sends data to subscriber **731** and **733** over a wireless digital packet switched network **712**. The Office Action finally asserts that wireless subscriber sends and receives information from the **IM Server** via the WAP IM while maintaining contact with a remote system via the WAP browser.

Applicants respectfully but completely disagree with the Office Action’s assertions. Applicants point out that McDowell merely describes that only a WAP browser is running on the first computing device and that the WAP browser then communicates with a WAP IM

application that is resident and executing **on the IM Server** and not on the first computing device. Therefore, McDowell does not describe that both a WAP IM and a WAP browser are both running on the first computing device.

In support of this distinction, Applicants respectfully point out that McDowell describes that the wireless subscriber instant messaging capability is provided through a **WAP client or a two-way SMS web page** which is *resident in the PLIM 110*. A PLIM 110 is a **server side** combination gateway, IM server and presence server (FIGS 1-3, Para. 0042-0043) and is operated by the service provider. PLIM 110 is not a client side device.

In McDowell, the subscriber (i.e. the subscriber device **210**) goes to a web page on the *WAP IM client* operated by her wireless carrier and that the *WAP IM client* allows subscribers to carry on all of the IM activities (Para. 0092, 0098-0099). It is explicitly described that that “the WAP Client resides either on a web server inside the wireless carrier’s firewall, or behind the firewall of a PLIM system gateway site”. (Para. 0098). It is further described that the *WAP IM client* is accessible via a standard web browser and that the *WAP client* provides full IM capabilities (Para. 0097).

Therefore, McDowell is clearly describing that the WAP IM client, operated at the service provider by the service provider, is running an IM application and that the wireless subscriber device **210** is merely running a WAP Browser that is accessing the WAP IM Client at the service provider in order to create an IM or Buddy lists. McDowell is not describing the subscriber device **210** is itself running both a WAP IM application and a WAP browser.

In further support of Applicant’s position, McDowell expressly and impliedly concedes that subscriber wireless device **210** does not run an embedded IM or buddy list application. McDowell states that “[i]n the future, WAP and SMS may give way to...embedded IM and buddy lists in client wireless devices themselves”. (Para. 0095). As such, McDowell is expressly confirming that embedded wireless instant messaging applications did not exist in subscriber wireless devices at the time of McDowell’s filing and was merely speculating on hope to be future developments. Therefore, for this additional reason, McDowell can not be describing a messaging application running on the first computing device because McDowell states that such an arrangement did not exist at the time of the filing of McDowell. In fact, the whole point of McDowell is to provide IM functionality to mobile client devices that can not run a WAP IM application.

Therefore, when McDowell describes that the IM server allows wireless networks to send and receive instant messages from common IM platforms (Para. 46), McDowell is NOT describing or implying that subscriber wireless device **210** is sending and receiving instant messages since McDowell concedes that it can not do so. (Para. 0095). McDowell is describing that the subscriber wireless device **210** is accessing the IM server whereby a web page of the IM server is manipulated by the wireless device **210** to compose and read a message. (Para. 0092). Therefore, McDowell fails to describe a “messaging application running on the first computing device over the wireless digital packet-switched network” as recited in independent claim 8.

In his response to Applicants’ previous arguments, the Examiner cites paragraph 50 and paragraph 59 of McDowell as describing conclusively that the subscriber wireless device **210** includes a messaging application. Applicants respectfully disagree.

Paragraph 0050 merely describes that the Presence Server **112** determines if a wireless device is on or off and that software on the handset **210** can indicate whether it is on or off. Software indicating that a buddy is on or off that is provided by a Presence Server is not describing that the wireless device includes “an IM messaging application running on the first computing device”. As mentioned above, paragraph 0095 states that buddy lists capability embedded in the hand set does not yet exist but may in the future. A mere presence On/Off indication is not a “Buddy List”.

The Office Action also points to paragraph 0059 in support. However, paragraph 0059 merely describes that the PLIM (i.e. the IM server) retrieves online presence from various IM servers and makes it available to wireless subscribers on the WAP IM client, which is located in the PLIM and not on the wireless communication device **210**. The wireless communication device **210** is merely looking at a web page executing on the WAP IM client (e.g. the IM Server).

Applicants respectfully point out another discrepancy in McDowell. Amended independent claim 8 recites, in pertinent part, “...determining a plurality of intended recipients of the data at the messaging server and forwarding the data from the messaging server directly to the intended recipients without transmitting the data through the protocol server...”

Applicants respectfully disagree that McDowell describes that the wireless subscriber device **210** sends data to subscribers **731** and/or **733** over a wireless digital packet switched network **712** as relied upon by the Office Action. No such capability is described by McDowell.

FIG. 7 and its related discussion is merely describing that merchants **731** and **733** may access the PLIM server **704** to “facilitate presence and location information between networks”. (Para. 0084). The functionality of FIG. 7 and its discussion is completely separate from the discussion in McDowell concerning the interaction between the wireless communication device and the IM Server shown of FIGs. 2 & 3. There is no discussion of an IM message from wireless communication device **210** being forwarded to merchants **731** or **733** by the PLIM or any PLIM component. Any such assertion requires a leap of logic that the PLIM **110**, or some component thereof, forwards IM messages from the IM server to the Network API **117** and then to merchants **731** and/or **733**. As such, McDowell fails to describe determining a plurality of intended recipients of the data at the messaging server and forwarding the data from the messaging server directly to the intended recipients without transmitting the data through the protocol server determining a plurality of intended recipients of the data at the messaging server. Therefore, amended claim 8 is allowable for at least this additional reason.

Further, Applicants respectfully point out that McDowell merely describes an IM message being sent from the IM Sever to a single recipient. McDowell does not describe “...forwarding the data from the messaging server directly to the intended recipients...” or that the McDowell system has the capability to send an IM message to multiple recipients. As such, amended independent claim 8 is allowable for at least this additional reason.

Furthermore, for prior art to anticipate within the context of §102, the prior art must contain enabling disclosure of the asserted subject matter. The mere naming or description of the subject matter is insufficient if it can not be produced without undue experimentation. (MPEP 2121.01). Since McDowell expressly describes that the technology for wireless IM capability or for embedded IM/buddy lists in wireless devices did not exist in the art at the time of its filing (para. 0095), its mere mention is not enabling of McDowell in this respect. Because the public was not in possession of the knowledge allowing the execution of an IM application on a wireless device prior to the filing date of the instant application, McDowell is not §102 prior art for the proposition that McDowell describes hat the wireless device includes “a messaging application running on the first computing device”.

Therefore, for at least the above reasons, McDowell fails to describe all of the claim elements and independent claim 8 is allowable over McDowell. Dependent claim 9 depends from an allowable independent claim 8 and is allowable for at least the same reasons.

### 103 Rejections

Claims 1-2, 4-6 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Abu-Samaha (U.S. Pat. 7,260,536) (hereinafter “Abu”) in view of Chandra (U.S. Pat. 7,130,885) and further in view of Doss (U.S. Pat. App. 2002/0188620). Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Abu in view of Chandra and further in view of Official Notice. Claims 8-9 stand rejected under Abu in view of Chandra.

Claims 7-10 and 12-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell in view of Doss and/or Parsons (U.S. Pat. App. 2002/0085701) and Official Notice.

### Claims 8-9

Claims 8-9 stand rejected under Abu in view of Chandra. The Office Action rejects independent claim 8 by asserting that Abu describes most of the claim elements but concedes that Abu fails to describe “initiating a first communication through a communication layer by the first application using a first application program interface (API) call for contacting the remote server; initiating a second communication through the communication layer by the second application using a second application API call for sending instant message server which directly forward[s] it to the at least one of the plurality of second computing devices”. The Office Action proceeds by asserting that Chandra cures the conceded deficiencies of Abu.

However, Applicants respectfully note that the combination of Abu and Chandra fails to describe other elements of amended independent claim 8. For example, the combination of Abu and Chandra fails to describe an instant messaging server.

Amended independent claim 8 recites, in pertinent part:

“[a] method of receiving data sent from a first computing device by a plurality of second computing devices over a wireless digital packet-switched network, the method comprising ...forwarding the data from the instant messaging application to an *instant messaging server* via the protocol server; determining a plurality of intended *recipients of the data at the instant messaging server*; and forwarding the data *from the instant messaging server* directly to the intended recipients without transmitting the data through the protocol server.”

Abu addresses itself to a system for receiving collaboration service requests to a “messaging/collaboration” database server 33 (Col. 2, l. 23-25) from wireless devices 26 and providing “messaging/collaboration service deliverables” to the wireless devices 26. Request

messages and service deliverables are described as being transmitted back and forth using a communication protocol such as voice, internet and wireless formats. (Col. 4, l. 37-61).

Although Abu mentions the parenthetical phrase “instant messaging” (Col. 2, l. 38) once in passing as being a collaboration service, Abu is absolutely silent as to wireless device 26 or access server 34 operating in the instant messaging domain or that the system described in Abu utilizes an instant messaging server or uses an instant messaging application in any form. In fact, Abu expressly describes that “[c]ommunications from wireless device 36 are in accordance with the Wireless Application Protocol (WAP). An internet wireless gateway 38 converts the WAP communications into HTTP messages that may be processed by access server computer 34.”

Further, Abu describes operating to provide non-IM messaging data services such as e-mail, calendar and voice mail. Specifically, Abu describes messaging/collaboration server 33 as storing and providing real time access to e-mail, calendar, contacts and tasks data (Col. 5, l. 32-37). As such, Applicant respectfully asserts that neither access server 34 nor messaging/collaboration server 33 is an IM server as would be recognized by one of ordinary skill in the art. A server that merely provides stored data is a data base server and not an Instant Messaging server.

Because the wireless device 36 is described as communicating in WAP and is not described as executing an IM messaging application and because neither access server 34 nor messaging/collaboration server 33 is or can be inferred to be an IM server as asserted by the Office Action, Abu fails to describe the subject matter asserted to Abu by the Office Action.

Applicants respectfully assert that it is a leap of logic based on inappropriate hindsight after reading Applicant’s specification to infer from Abu that the data is being transferred from wireless device 36 and is being forwarded from an instant messaging application or that access server 34 messaging/collaboration server 33 is an IM server. For at least the above reasons, Abu fails to describe forwarding the data from the instant messaging application to an instant messaging server via the protocol server, fails to describe determining a plurality of intended recipients of the data at the instant messaging server and also fails to describe forwarding the data from the instant messaging server directly to the intended recipients without transmitting the data through the protocol server.

As for Chandra, on page 5 the Office Action asserts that Chandra describes an instant messaging server and cites the Microsoft® exchange server (item 2008) of figure 2D as being an

instant message server. However, Applicants respectfully note that Chandra merely concerns itself with organizing related content portions of e-mail messages within the messages in a way to make the content easy to find. (Col. 3, l. 65-67). Chandra specifically criticizes instant messaging as requiring two users to be available simultaneously (Col. 4, l. 63-67) but notes the advantage of being timely.

Chandra proceeds to describe the exchange server 2008 includes instant messaging “support” with presence detection API’s such that the exchange server knows a particular user utilizes instant messaging for communications. However, the mere use of a presence API is not describing that the exchange server 2008 is an instant message server since no instant messages are sent or received by the exchange server 2008. Nor does the use of a presence API describe that data is being forwarded from an IM application.

To the contrary, Chandra clearly describes that the client device is an Outlook® client (Fig 2D) which communicates via a mail application programming interface (MAPI). (Col. 17, l. 45-47). Outlook® and MAPI are e-mail systems and are not instant messaging systems.

Since Chandra only discusses presence API’s and explicitly describes that the Exchange Server 2008 is an e-mail server, Exchange Server 2008 is therefore not an instant message server. Chandra fails to describe forwarding the data from the instant messaging application to an **instant messaging server** via the protocol server; fails to describe determining a plurality of intended recipients of the data at the **instant messaging server**; and fails to describe forwarding the data from the **instant messaging server** directly to the intended recipients without transmitting the data through the protocol server.

Therefore, since none of Abu, Chandra or their combination describes each and every claim element, amended independent claim 8 is allowable over the combination of Abu and Chandra for at least these reasons.

Further, there is no motivation to combine Abu and Chandra as Chandra is actually teaching away from the instant messaging server as recited in the claims. A prima facie case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claim elements. (MPEP 2144.05(III)). As discussed above in regards to the §103 rejections against amended independent 8, Chandra describes that instant messaging is too constrictive in that users must be simultaneously signed on and a message cannot be sent to multiple recipients. As such, Chandra is teaching away from instant messaging in favor of e-mail with the use of a

presence API. Therefore, because Chandra is teaching away from the use of an instant messaging server, there is a lack of motivation to combine Chandra with Abu. As such, amended independent claim 8 is allowable over the combination of Abu and Chandra for at least this additional independent reason.

Claim 9 depends from an allowable amended independent claim 8 and is allowable for at least the same reasons.

#### Claims 1-2, 4-6 and 11

Claims 1-2, 4-6 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Abu in view of Chandra and further in view of Doss. Independent claim 1 recites, in pertinent part:

“[a] method of sending data from a first computing device to at least one of a plurality of second computing devices over a wireless digital packet-switched network, the method comprising... the second application providing an **instant messaging service** and enabling instant messaging data to be sent from the first computing device to **a instant messaging server** within the private network via the protocol server over the wireless digital packet-switched network...wherein the instant message is delivered to **the instant messaging server for further delivery to the at least one of the plurality of second computing devices** within the private network without transmitting the instant message through the protocol server.

As described above in regards to amended independent claim 8, the combination of Abu and Chandra fails to describe the use of an instant messaging server. Further, Chandra teaches away from the use of an instant messaging system using an instant messaging server.

Amended independent claim 1 recites providing an instant messaging service and that an instant message is delivered to the instant messaging server for further delivery. Because the combination of Abu and Chandra fails to describe an instant messaging server and Chandra teaches away from using an instant messaging server, amended independent claim 1 is allowable over the combination of Abu and Chandra for at least the same reasons.

Further, Doss is concerned with enhancing directory search results with calendar based search results and does not address instant messaging at all. Therefore, Doss fails to cure the above deficiencies in the combination of Abu and Chandra. As such, amended independent claim 1 is allowable for at least these reasons. Claims 2, 4-6 and 11 depend from an allowable amended independent claim 1 and are allowable for at least the same reasons.

In regard to claim 5, the Office Action concedes that the combination of Abu and Chandra fails to disclose that the user identifier comprises one of a group of allowed recipients, the method further comprising detecting at the instant messaging server whether the user identifier is of the group of allowed recipients, and delivering the message to the recipient only when the user identifier is of the allowed group. The Office action proceeds by asserting Official Notice that such a method is “well known and expected in the art”.

Official Notice unsupported by documentary evidence is permissible only in some circumstances. These circumstances should be rare when an application is under final rejection. Undocumented Official Notice should only be taken where the facts asserted to be well-known are capable of instant and unquestionable demonstration as being well known at the time of filing as to defy dispute. (MPEP §§2144.02-03). Specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *Id.* “Facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice. *Id.*, (quoting *In re Eynde*, 480 F.2d 1364, 1370 (CCPA 1973)). If such notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical grounds and scientific reasoning to support his conclusion.

Applicants disagree with the Examiner’s Official Notice and respectfully demands a written reference to substantiate the Official Notice. Being a question of the state of the art at the time of filing in 2001, Applicants respectfully assert that the Office Notice fails to rise to the standard of unquestionable demonstration as being well known such as to defy dispute.

For example Chandra specifically states that instant messaging is only useful if the other party is signed on and present. (Col. 4, l. 62-67). Therefore as of Chandra’s filing date of September 2001, Chandra is implicitly stating that an IM message is deliverable in real time only to a particular addressee. That particular addressee, by definition, is the only allowed recipient in an IM messaging environment. Therefore, it is at least questionable as to whether the concept of detecting at the instant messaging server whether the user identifier is one of a group of allowed recipients was well known in the art as of the September 2001 filing of the instant application. Such a feature would not have been necessary in a standard instant messaging system. Because it is at least questionable that the Official Notice defies dispute, Applicants demand a written notice to produce a reference to support the Office Action’s assertion. (MPEP 2144.03(C)).

Because the combination of McDowell, Doss and Parsons is conceded not to describe “detecting at the instant messaging server whether the user identifier is of the group of allowed recipients, and delivering the message to the recipient only when the user identifier is of the allowed group” and the Official Notice is inadequate, then Claim 5 is allowable over the combination of McDowell, Doss/Parsons and the Official Notice for at least this additional reason.

#### Claims 7-9 and 12

Amended independent claim 7 recites, in pertinent part:

“[a] method of sending data from a first computing device to at least one of a plurality of second computing devices over a wireless digital packet-switched network...the second application providing an instant messaging service and enabling instant messaging data to be sent from the first computing device to a instant messaging server within the private network via the protocol server over the wireless digital packet-switched network;  
generating data to be sent from the first computing device to the at least one of the plurality of second computing devices within the private network, wherein data is generatable... from the second application as an instant message...”

In its rejection, the Office Action asserts that McDowell teaches or suggests most of the claim elements. The Office Action concedes that McDowell fails to describe that instant messaging data being sent from the first computing device to an instant messaging server within a private network via the protocol server over a wireless digital packet-switched network. The Office Action also concedes that McDowell fails to describe a wireless modem at the client device and an access point device in order to initiate a request to a modem controller for access to a wireless digital packet switched modem.

The Office Action further asserts that Parsons describes an office which includes a private network which has a plurality of clients for exchanging instant messages with a wireless device. However, the Office Action concedes that the combination of McDowell and Parsons/Doss does not describe a wireless modem at the client device and an access point device in order to initiate a request to a modem controller for access to a wireless digital packet switched modem. The Office Action proceeds by asserting Official Notice that cures this conceded deficiency.

It is respectfully submitted that as discussed above in regards to the §102 rejections concerning amended independent claim 8, McDowell does not describe the subject matter relied

upon by the Office Action because McDowell does not describe an IM application executing on the wireless communication device **210**. For example, McDowell does not describe “initiating a second application on the first computing device, the second application providing an instant messaging service and enabling instant messaging data to be sent from the first computing device...wherein data is generatable ...from the second application **as an instant message.**”

Further, neither Doss nor Parsons cures these additional deficiencies of McDowell as neither Doss nor Parsons is concerned with instant messaging. Doss is directed to a dynamically enhanced database search comprising a static database and a dynamic database. Because Doss does not address the use of an IM application on a computing device (i.e. the first computing device), Doss fails to cure this additional deficiency of McDowell.

Parsons is directed to a presence detection system for a telephone system and does not appear to describe the use of an IM Service. Therefore, since Doss, Parsons and their combination fail to cure the discrepancies of McDowell, the combination of McDowell, Parsons and Doss fail to describe each an every claim element. As such, amended independent claim 7 is allowable over the combination of McDowell, Doss and Parsons.

Amended independent claim 8 contains similar recitations and is, therefore, allowable over the combination of McDowell, Doss and Parsons for at least the same reasons. Dependent claims 9 and 12 depend from an allowable independent claim 7 or 8 and are allowable for at least the same reasons.

#### Claims 10 and 13

In regards to claims 10, amended independent claim 10 recites, in pertinent part:

“[a] system for sending data over a wireless digital packet-switched network from a first computing device to at least one of a plurality of second computing devices...comprising...the first computing device implementing ...an instant message application that generates instant messages...and wherein the protocol server ...receives the instant messages and forwards them to the instant messaging server for delivery...”.

For the reasons discussed above in regards to the §102 rejections, McDowell is not describing the first computing device implementing ...**an instant message application that generates instant messages**...and wherein **the protocol server ...receives the instant messages** and forwards them to the instant messaging server for delivery. McDowell merely accesses an IM web page via a WAP browser. The IM server hosting the web page then

generates the instant messages. The first communication device is not implementing an instant messaging application wherein the protocol server is receiving the instant message. The instant message is being generated on the IM server which is on the back side of the protocol server. Therefore, McDowell fails to describe the subject matter for which McDowell was asserted. As neither Doss nor Parsons discusses the use of an IM application on a wireless device, Doss fails to cure this particular deficiency of McDowell.

Therefore, Applicants respectfully assert that the combination of McDowell, Doss and Parsons fails to describe all of the claim elements of amended independent claim 10. Amended independent claim 10 is therefore allowable over the combination of McDowell, Doss and Parsons. Claim 13 depends from an allowable independent claim 10 and is allowable for at least the same reasons.

#### Conclusion

In view of the foregoing amendments and remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicants' attorney at the number listed below.

No fees are believed due. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025

Respectfully submitted,

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